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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,918	11/20/2000	Jay S. Walker	98-010X	9324

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EXAMINER

LEIVA, FRANK M

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,918

Applicant(s)

WALKER ET AL.

Examiner

Frank M. Leiva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/05/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/28/2004 has been entered.

Terminal Disclaimer

2. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 50-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No.

6,203,430. Although the conflicting claims are not identical, they are not patentably distinct from each other. The limitations of the instant claims including a method and a gaming device with a processor that tracks and counts the occurrence of a tracked symbol, increments or decrements the count value associated with the occurrence of the tracked symbol and associates an expiration condition and bonus payout based on the occurrence of the tracked symbol are taught by the claims of US 6,203,430.

5. Claims 50-77 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/778,576. This is a provisional obviousness-type double patenting rejection. The limitations of the instant claims including a method and a gaming device with a processor that tracks and counts the occurrence of a tracked symbol, increments or decrements the count value associated with the occurrence of the tracked symbol and associates an expiration condition and bonus payout based on the occurrence of the tracked symbol are taught by the claims of Application No.

09/716918.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 50-54, 56-58, 60-62 64-69, and 71-77 are rejected under 35 U.S.C.

102(e) as being anticipated by Barrie (US 5,833,537)

7. Regarding claims 50-53, 65-68, and 71-77 Barrie teaches generating at least one outcome wherein each outcome includes a plurality of instances selected from a plurality of machine symbols appearing on a plurality of pay-lines (Figure 1 & Abstract). The set of machine symbols including a plurality of persistent (tracked) slot machine symbols (124a, 124b, 124c) wherein on the occurrence of a persistent symbol a running count is adjusted in a respective counting grid (142, 144, Figure 7) respectively. The symbols of Barrie further independently expire due to the passage of time and/or the playing a predetermined number of subsequent rounds (Abstract). Barrie additional teaches the awarding of a bonus payout as determined by the count present in the counting grid (Figure 5).

8. Regarding claim 54, Barrie teaches counting of tracked symbols for any payout amount (Figure 3). As so claimed the tracking of predetermined symbols occurs for any payout amount less then the predetermined amount above the maximum payout

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amount. In this light the applicant's "less than a predefined amount" is equated to any amount predefined above the maximum payout amount.

9. Regarding claim 56, Barrie teaches remote game administration (Col 4:42-4:60) including a server system (central computer) for game state operation and tracking.

Barrie utilizes remote hardware game management including all related processing functionality this is understood to encompass the storage and execution of software as well as performing as a server of the game to the remotely located player.

10. Regarding claims 57 and 58, the claimed determination of a bonus payout based on the number of plays and/or the a duration of time is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid.

11. Regarding claim 60, Barrie teaches awarding payouts (Figure 3 & Element 326) in response to the count and a placed wager (312), where the count excludes expired symbols (322). (Col 5:60-65).

12. Regarding claim 61, Barrie teaches the use of offsetting Symbols (black ball) for decrementing the count value with each occurrence of the black ball on a persistent symbol location (Col 4:8-22).

13. Regarding claim 62, Barrie teaches the use of multiplier symbols wherein the bonus payout includes the determination of a multiplier to be applied to the payout (Figure 4).

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14. Regarding claim 64, Barrie teaches associating a zero payout for those symbols which have expired (Col 8:1-10 & Abstract) and as such encompasses the claimed "determining a payout for expired occurrences of the at least one tracked symbol".

15. Regarding claim 69, Barrie teaches the use of a video poker embodiment including the use of playing cards (Col 3:2-5).

16. Regarding claim 74, Barrie teaches the incorporation of CPU (214) for the execution of game device taught above.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 55, 59, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5833,537) in view of Weiss (US 6,165,071).

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20. Barrie teaches the inclusion of a "player card" however is silent regarding the memory, tracking, and player compensation abilities capabilities of said player card (Col 5:47-49). In a related application however Weiss teaches the use of a player card system (Weiss Col 2:24-27) for allowing a player to complete a game a in a series of gaming sessions including the storage of the player's current game state (Weiss Col 3:11-22), player tracking functions (Weiss Col 1:39-67), and the determination of player rewards for continued play (Weiss Col 1:39-56). It would have been obvious to one of ordinary skill in the art at the time of invention to have to have incorporated the continued play incentive program including the portions described above into the system/method of Barrie in order to encourage continued game play among player's.

21. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5833,537).

22. Barrie teaches providing a payout based on the results of a first game, the counting of predetermined symbols, and embodiments which further include the use of card games (Col 3:2-5) as taught above however Barrie is silent regarding the use of face value cards for the purpose tracked symbols. As no stated problem is solved or unexpected result obtained in the utilization of card face values in the place of the symbols of Barrie this feature is deemed to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of invention to utilization of card face values in the place of the symbols of Barrie in order to allow the persistent symbol feature depiction in order to correspond the persistent symbols to a desired game theme.

Response to Amendment

23. The applicant's arguments filed on 12/19/2005 under 37 CFR 1.131 have been considered but are ineffective to overcome the Barrie (US 5,833,537) reference.

24. In regards to claims 50, 71, and 74;

- Determining a number of occurrences of at least one tracked symbol
- Determining whether the number is at least a minimum number;
- Providing, if the number is at least a minimum number, a bonus payout.

25. If you observe Fig. 5, Barrie's invention tracks a symbol at #516, checks if it reaches a certain number at #518, and if it is reached it awards a bonus at #520.

26. The examiner takes the position that multiplying a payout is a bonus feature that is awarded to a player. A bonus can have many forms, food comps, free play, credits, and multiplier rounds.

27. "the mere occurrence of these symbols do not occasion a payout as in claims 50, 71, and 74", claims 50, 71, and 74 do not mention a payout when a symbol appears, The examiner reads, counting, if the count reaches a number, and an expiration, but the words "mere occurrence" of variations of that image cannot be found by the examiner.

28. In regards to claim 72 arguments;

- determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence
- providing a bonus payout when the count value exceeds the bonus value

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29. Barrie's invention states in the description of Fig. 3 (Col 5:27-52), incrementing the count, decrementing the count and expiration limits, combined with the description of Fig. 5 (Col 6:27-50), covers this argument.

30. In regards to claims 51-54, 56-58, 60-62, 64-69, 73, and 75-77, they continue to stand rejected under the same reference since no other arguments have been presented.

31. In regards to claims 55, 59, and 63, stands rejected under the same references, since the argument about a payout after a tracked symbol reaches a specific number is easily seen in Barrie's Fig 5 and expressed in the description of Fig.5 (Col 6:27-50).

32. The applicant also states that no motivation to modify the reference has been provided, but fails to specifically show where the examiners motivation statements fails to comply with 35 U.S.C 103(a).

Conclusion

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 8:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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